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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,456	06/13/2001	Melanie Brunner	48662/DIV	6527

7590 12/12/2001
Herbert B. Keil
KEIL & WEINKAUF
1101 Connecticut Avenue, N.W.
Washington, DC 20036

EXAMINER

FOROHAR, FARHAD

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 12/12/2001

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/879,456

Applicant(s)

BRUNNER ET AL.

Examiner

farhad

forohar

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. In claims 14 and 15 the phrase "plasticizing amount" is indefinite.
4. In claim 14 the phrase "increasing the plasticity" is indefinite.

Claim Rejections - 35 USC § 102

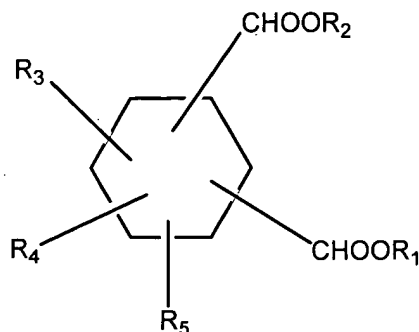
5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakurai et al (JP 07-173342 or 07-011074 or 06-306252).

The present invention recites a group of compounds of 1,2-dialkyl cyclohexanedicarboxylic acid esters with the dialkyl groups being defined in claims 12 and 13. Sakurai et al teach a cyclohexane structure as shown below:



Where, R₃₋₅ are hydrogen or other defined substituents, and R¹ and R² are 6-28C alkyl or alkenyl. Some examples of these compounds are diisononyl hexahydrophthalate, and didecyl hexahydrophthalate (STN abstract of JP 07-173342). These compounds are used for compositions having excellent low-temperature impact resistance, flexibility, and moldability.

Compounds are defined by their atoms and bonds and are not distinguished by the manner with which they are made.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Farhad Forohar. The examiner can normally be reached on Monday-Friday between the hours of 8:00 a.m. and 5:00 p.m. at (703) 305-1022.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Geist, SPE of Art Unit 1623, may be reached at (703) 308-1701. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4426.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-4556.

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December 07, 2001



GARY GEIST
SUPERVISORY PATENT EXAMINER
TECH CENTER 1600